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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,334	02/07/2001	Scott W. Huffer	9325-36	1473
23973	7590	01/31/2005	EXAMINER	
DRINKER BIDDLE & REATH ATTN: INTELLECTUAL PROPERTY GROUP ONE LOGAN SQUARE 18TH AND CHERRY STREETS PHILADELPHIA, PA 19103-6996			RAYFORD, SANDRA M	
			ART UNIT	PAPER NUMBER
			1772	
DATE MAILED: 01/31/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 09/778,334	<b>Applicant(s)</b> HUFFER ET AL.	
	<b>Examiner</b> Sandra M. Nolan	<b>Art Unit</b> 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11-17-04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submissions filed on 17 November 2004 have been entered.

### ***Claims***

2. Claims 1-19 and 27 are pending. Claims 20-26 have been cancelled.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 17 November 2004 was considered by the examiner.

4. Items missing from Office's eDAN/IFW file on 01 January 2005 were crossed off.

### ***Withdrawal of Allowability***

5. The allowability of claims 1-19 and 27 is withdrawn in order to apply the new grounds of rejection below.

### ***New Rejections***

#### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-19 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkie (US 5,792,549) in view of Curatolo et al (US 5,888,649) and Pike et al (US-4,810,745).

Wilkie teaches packaging films comprising polypropylene substrates coated with cold seal release layers and cold seal receptive layers (abstract). The release layers contain non-migrating slip agents (col. 5, lines 35-45). The cold seal receptive layer contains copolymers derived from acrylic acid to improve adhesion to the cold seal layer (col. 6, lines 33-40).

Wilkie's "non-migrating" slip agents are deemed to be reacted-in slip agents. Its "cold seal receptive layer" is deemed to be a cold-seal cohesive layer.

Wilkie fails to teach a radiation-cured release layer or rubber in its release layer.

Curatolo teaches electron beam (EB) and ultraviolet light (UV) cured release layers in printable (col. 1, line 15) and environmentally friendly coatings (col. 1, lines 36-

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39) for films (col. 1, line 14). Its release layers contain polymers from acrylate monomers (col. 3, lines 39-46) and include epoxy acrylates (col. 6, line 39).

Pike teaches rubbers in cold seal coatings (col. 4, line 66 through col. 5, line 20). The coatings are used in packaging films (col. 1, lines 22-32) for candy and other temperature-sensitive products (col. 1, lines 32-45).

The patents are analogous because they all deal with coated films.

It would have been obvious to one having ordinary skill in the art at the time of the invention to employ the EB- and UV-curable release coatings of Curatolo and the rubber cold seal coatings of Pike when making the packaging films of Wilkie in order to render Wilkie's films printable, and environmentally friendly (per Curatolo) as well as useful for temperature sensitive products (per Pike).

The motivation to use Curatolo's release layers is found at col. 1, lines 15 and 36-39, where printability and environmental concerns are discussed.

The motivation to use Pike's cold seal coatings is found at col. 1, lines 32-45, where the use of films having its coatings for packaging candy and temperature-sensitive products is taught.

It is deemed desirable to make packaging films that are printable, environmentally friendly and useful for temperature-sensitive products in order to enhance consumer acceptance of the products in which they are used.

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-19 and 27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 10/794,100 in view of Wilkie.

This is a provisional obviousness-type double patenting rejection.

The claims of the '100 application, as worded on 04 March 2004, cover packaging films, and methods of making them, which differ from the instant films only in that they do not recite reacted-in slip agents.

Wilkie is discussed above. Note that it teaches non-migratory slip agents, which agents are deemed to be reacted in slip agents. At col. 5, lines 35-40, it says that the slip agents give the films beneficial frictional properties.

In the absence of convincing objective evidence to the contrary, it would have been obvious to one having ordinary skill in the art at the time of the invention to employ the slip agents of Wilkie in the films of the '100 application in order to give them the frictional properties Wilkie discusses.

It is deemed beneficial to make films having improved frictional properties so that they may be handled easily.

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11. Claims 1-19 and 27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/702980.

This is a provisional obviousness-type double patenting rejection.

The '980 application claims, as worded on 26 November 2004, cover methods of making packaging films that comprise:

- a plastic substrate
- printing ink on one side of the substrate
- an energy-cured coating containing a reacted-in slip agent over the ink
- a cold-seal cohesive coating on the other side of the substrate.

Thus, the '980 application claims differ from the claims of the instant application only in that an ink is used on the same side as the energy-cured coating.

In the absence of convincing objective evidence to the contrary, it would have been obvious to one having ordinary skill in the art at the time of the invention to omit the ink on the substrate of the '980 films in order to make unprinted films.

It is deemed beneficial to make films that are unprinted so that the contents of the package are more easily viewed.


### ***Conclusion***

Any inquiry concerning this communication should be addressed to Sandra M. Nolan-Rayford, at telephone number 571/272-1495. She can be reached Monday through Thursday, from 6:30 am to 4:00 pm, ET.

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If attempts to reach the examiner are unsuccessful, contact her supervisor,  
Harold Pyon, at 571/272-1498.

The fax number for patent application documents is 703/872-9306.

  
S. M. Nolan-Rayford  
Primary Examiner  
Technology Center 1700

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